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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/882,197	06/25/1997	PAUL GREER	42390.P4072	3875

7590 02/25/2002

BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

2163

DATE MAILED: 02/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

146

**Advisory Action**

Application No.

08/882,197

Applicant(s)

GREER ET AL.

Examiner

Susanna M. Diaz

Art Unit

2163

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- ☒ a) The period for reply expires 3 months from the mailing date of the final rejection.
- ☐ b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): None.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

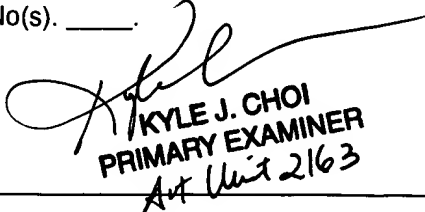
Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-14 and 16-57.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
KYLE J. CHOI  
PRIMARY EXAMINER  
Art Unit 2163

**CONTINUATION SHEET (Advisory Action - Paper No. 28)**

**Continuation of 2.** NOTE: While it would appear that the same limitations are presented for examination in the proposed amendment, the Applicant has amended the claims to alter claim dependencies in such a way that the scope of the claims is altered as well. This change in scope requires further consideration of the claims.

**Continuation of 5.** does NOT place the application in condition for allowance because: The Applicant's arguments are non-persuasive.

Firstly, Applicant argues that there is no motivation within the cited references to establish a valid prima facie case to support the rejection under 35 U.S.C. 103; however, in response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner combined teachings from Dedrick along with knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to establish a valid prima facie case in the rejection under 35 U.S.C. 103 (please refer to section 7 of paper no. 26).

Secondly, the Applicant implies that the art rejection does not address "a system and method to customize and target advertisements to particular audiences more likely to be interested in the particular advertisement or to which the advertising particularly pertains" in order to more effectively utilize bandwidth resources (page 9 of Applicant's response, paper no. 27). The Examiner respectfully submits that Dedrick does indeed speak to this concept. As a matter of fact, a similar argument was already addressed on page 3 of paper no. 26 and Applicant was directed to the following excerpts from Dedrick: Figure 3a; col. 3, lines 6-26; col. 4, lines 4-8; col. 9, lines 57-65; col. 10, line 62 through col. 11, line 33.

In conclusion, Applicant's arguments are not persuasive.